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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/690,680
Filing Date: October 22, 2003
Appellant(s): RHEE ET AL.

Alan E. Wagner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 19 September 2007 appealing from the Office action mailed 19 March 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

Withdrawn Rejections

The Final Rejection mailed 19 March 2007 contained a rejection of Claims 1 and 3-7 under 35 U.S.C. 102(b), or in the alternative under 35 U.S.C. 103(a) in view of McKinney. Only the 35 U.S.C. 102(b) portion of the rejection over McKinney (USPN 4430289) is withdrawn. The rejection of Claims 1 and 3-7 under 35 U.S.C. 103(a) as obvious over McKinney is maintained and is set forth below.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,430,289	MCKINNEY et al.	2-1984
5,132,344	MATTEODO	6-1992
4,594,213	EALER	6-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim recites "about 100 ppm" which incorporates some values above 100 ppm. The scope of Claim 1 recites an endpoint of 100 ppm, and therefore Claim 3 broadens the endpoint to include values above, but "about", 100 ppm.

Claim Rejections - 35 USC § 103

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as obvious over McKinney (USPN 4430289).

As to Claim 1, according to the dictionary definition found in Merriam-Webster's Collegiate Dictionary (page 1299), "up to" refers to extension as far as a specified place (definition 1) or the

limit (definition 2). Based upon the definition of "up to", the claim scope is interpreted to include 100 ppm.

The article of McKinney is inherently capable of performing the claimed intended use because it is inherently capable of stretching and wrapping. McKinney teaches film blowing (Abstract, line 3) a composition containing a first linear low density polyethylene resin (4:25) and about 100 ppm by weight of particles having a mean particle size of less than 0.05 microns (3:35-40 and 4:20-21), which would inherently have improved the cling force of a stretch wrap film. McKinney teaches that these particles may be zinc oxide (4:14-21). Although McKinney teaches zinc oxide as one of a group of possible particulate materials (4:14-20), and because it is not the most preferred option of these particulates (4:18-19), it is unclear that McKinney provides sufficient specificity to anticipate the claim. However, one would have been motivated and found it obvious to explore all possible particles and sizes suggested by McKinney. **As to Claim 3**, McKinney teaches a range of 100 ppm to 20000 ppm zinc oxide (3:35-40). The Examiner maintains the position that these claims are obvious by McKinney's teaching of about 100 ppm ("about 0.01" at 3:36-39). **As to Claim 4,** this aspect would have been inherent in the claimed method because McKinney teaches the same particle, particle size, and weight percent in the same material. **As to Claim 5,** McKinney teaches mixing a linear low density polyethylene resin with about 100 to 500 ppm (3:35-40) of particles having a particle size of less than 0.05 microns (4:20-21), and forming the mixture into a film (4:36), which would have inherently been capable of stretching and wrapping. McKinney teaches that these particles may be and zinc oxide (4:14-21). McKinney teaches zinc oxide as one of a group of possible particulate materials (4:14-20), and because it is not the most preferred option of these

particulates (4:18-19), it is unclear that McKinney provides sufficient specificity to anticipate the claim. However, one would have clearly been motivated to explore all possible options suggested by McKinney, and therefore the particular particle size and amount would have been prima facie obvious. **As to Claim 6,** mixing was conducted while molten in McKinney's method (5:14-37). **As to Claim 7**, blow molding is a blown film process (4:37 and 5:1-13).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKinney (USPN 4430289) in view of Ealer (USPN 4594213). Claim 5 was rejected under 35 USC 103(a) as obvious over McKinney above.

As to Claim 8, McKinney appears to be silent to the cast film process. However, Ealer teaches slot cast extrusion (column 9), which is interpreted to be a cast film process, and also that blow molding and slot cast extrusion can be used interchangeably (Columns 8-9). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ealer into that of McKinney in order to produce the vastly improved optical properties of cast films over those of blow molded films (Ealer 9:56-60).

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as obvious over Matteodo (USPN 5132344).

As to Claim 1, according to the dictionary definition found in Merriam-Webster's Collegiate Dictionary (page 1299), "up to" refers to extension as far as a specified place (definition 1) or the limit (definition 2). Based upon the definition of "up to", the claim scope is interpreted to include 100 ppm.

The article of Matteodo is inherently capable of performing the claimed intended use because it is inherently capable of stretching and wrapping. Matteodo teaches film blowing (5:26) a composition containing a first linear low density polyethylene resin (2:63-64) and 100 ppm by weight of zinc oxide particles having a mean particle size of 0.05 microns (3:33 and 2:35-36). The Examiner's position that Matteodo's teaching of the endpoint of the range at 100 ppm and a size of 0.05 microns is sufficient to render the claimed limitations prima facie obvious in order to provide resistance to coloration. **As to Claims 3**, Matteodo teaches a preferred range of 100 ppm (2:35-36) to 1500 ppm (3:53). The Examiner has reconsidered his position with regard to this claim but maintains the position that these claims are obvious over Matteodo's teaching of 100 ppm in order to provide resistance to coloration. **As to Claim 4,** this aspect would have been inherent in the claimed method because Matteodo teaches the same particle, particle size, and weight percent in the same material. **As to Claim 5,** Matteodo teaches mixing a linear low density polyethylene resin with 100 ppm (2:35-36) of zinc oxide having a particle size of 0.05 microns (3:33), and forming the mixture into a film (5:27), which would have inherently been capable of stretching and wrapping. **As to Claim 6,** mixing was conducted while molten in Matteodo's method (6:24-29). **As to Claim 7**, blow molding is a blown film process (5:27).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matteodo (USPN 5132344) in view of Ealer (USPN 4594213). Claim 5 was rejected under 35 USC 103(a) as obvious over Matteodo above.

As to Claim 8, the rotomolding process of Matteodo casts a film (5:26-27), and thus could be interpreted to a be a cast film process. However, in the alternative, Matteodo clearly suggests an extrusion process and that the compositions are especially suitable to the blown bubble process. However, Ealer teaches slot cast extrusion (column 9), which is interpreted to be a cast film process, and also that blow molding and slot cast extrusion can be used interchangeably (Columns 8-9). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ealer into that of Matteodo in order to produce the vastly improved optical properties of cast films over those of blow molded films (Ealer 9:56-60).

(10) Response to Argument

Issue 1

Appellants argue that the rejection under 35 USC 112, second paragraph would have been overcome by the amendment filed 19 June 2007. The Examiner agrees that the rejection would overcome by the amendment proposed in the 19 June 2007. The amendment was not entered due to the addition of new Claim 9 in that amendment, which would have required at least further consideration.

Issues 2 and 3

It is noted that the combination of Issues 2 and 3 in Appellants' brief addresses two different claim rejections (Rejection of Claims 1, 3-7 over McKinney and Rejection of Claim 8 over McKinney in view of Ealer). The combination of these issues has been noted and it is

further noted that the argument does not provide substantive arguments against the rejection of Claim 8 aside from its dependence on Claim 1.

With regard to Claim 1, Appellants argue that McKiney does not inherently teach the "improving the cling force of a stretch wrap film", as recited in the preamble. Instead, Appellants argue that McKinney teaches a method to decrease the cling force of a film. Appellants argue that McKinney shows that the additives decrease cling force.

Response

Before examining the merits of Appellants' argument, it should be noted that there is no factual dispute regarding the teachings of the reference pertaining to the type of particles, the particle size, the particle amounts, the polymeric resin, or the step of "forming", as set forth in the rejection above. Appellants' argument is, therefore, solely based upon the assertion that the reference fails to teach a resulting property recited by the preamble.

However, as set forth in the rejection above, McKinney provides a substantially identical process using the same components and additives. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection and the Examiner presents reasoning tending to show inherency, the burden shifts to Applicant to show an unobvious difference. M.P.E.P. § 2112(V). The PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product. *Id.* (citing *In re Fitzgerald*, 619 F.2d 67, 70). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of obviousness has been established. M.P.E.P. §

2112.01(I) (citing *In re Best*, 562 F.2d 1252, 1255). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *Id.* (quoting In re Spada, 911 F.2d 705, 709).

In this case, the Examiner asserts that by providing a reference showing the same or substantially the same fabrication process using the same or substantially the same components, the burden has shifted to Appellents to show an unobvious difference. The resulting products of Appellants and the prior art are structurally and compositionally identical, and made by the same or substantially the same process, and therefore a prima facie case of obviousness has been established by the rejection above.

Appellants attempt to rebut the position set forth in the rejection above by pointing to McKinney's Examples 2 and 3 and the associated tables, which are relied upon to show that the addition of additives decreases the cling force, as measured by film-to-film slip angle. However, it must be noted that these examples cannot be relied upon to rebut the Examiner's position because they use particle sizes of 8 microns or 1 micron, a different particle type, and amounts of 750-2500 ppm (6:33-67), which are substantially different than the claimed invention. Therefore, they are not pertinent to the particular teachings of the reference relied upon. There must be a nexus between the rebuttal evidence and the claimed invention. M.P.E.P. § 716.01(b) (citing *Ashland Oil, Inc. v. Delta Resins & Refractories*, 776 F.2d 281, 305). It is submitted that Appellant bears the burden of establishing the nexus. Here, the evidence of nonobviousness is of little probative value because it does not draw a factually significant connection between the teachings of the reference as a whole and the claimed invention. The tables relied upon are not the most pertinent teachings of the reference.

It is further noted that there are no examples in the record that actually establish that the inclusion of zinc oxide described in this application actually improves cling force in a film. All examples in the specification are directed at showing the effects of varying the amount or size of the particles. Even the "Control" samples shown on page 10 include zinc oxide. The "improved" cling force demonstrated by some samples in Tables 4.1 and 4.2 (Specification, page 10) only establishes that small amounts of small zinc oxide particles provide better cling than copious amounts of large zinc oxide particles. If the invention does no more than return the polyethylene sheet to its natural cling level by including less zinc oxide than has been traditionally used in the prior art, it is submitted that this "increased" cling level produced by the natural cling of the resin would not be an unexpected result. One of ordinary skill in the art recognizes and anticipates the properties of the film materials prior to the inclusion of additives.

Therefore, a prima facie case of obviousness has been made because the prior art teaches the method of making the film using substantially the same ingredients, and Appellants have not successfully rebutted the rejection above because the arguments point to evidence in the prior art which is of little probative value. There are no substantive arguments against the Ealer reference.

Issues 4

With regard to Claim 1, Appellants argue on page 10 that Matteodo teach a range from 100 ppm to less than 2000 ppm and that "While some of the ranges of the particular elements in Matteodo may overlap with ranges claimed in the present invention there is no teaching of the specific combination of the elements claimed." Appellants further argue on page 11 that to

arrive at the claimed invention would involve picking and choosing among the teachings of Matteodo. Appellants further argue that Matteodo teaches away from the smallest disclosed range of 0.5 microns to 2 microns by teaching that larger particles are preferred. Lastly, Appellants argue that Tables 4.1 and 4.2 in the instant application demonstrate unexpected results.

Response

As with the rejections over McKinney above, it does not appear that Appellants make any factual dispute regarding the reference pertaining to the type of particles, the particle size, the particle amounts, the polymeric resin, or the step of "forming", as set forth in the rejection above. Indeed, some of the ranges do meet the endpoints of the claimed ranges or overlap with the claimed ranges. A reference must be considered for all that it teaches, including non-preferred examples. In this case, Matteodo teaches amounts and sizes which meet the endpoint of the claimed ranges. The same polymer is used. The arguments set forth in the Examiner's response to Issues 2 and 3 above applies equally well here in establishing that the burden has shifted to Appellants to show nonobviousness.

In pointing to the instant specification, it is asserted that Tables 4.1 and 4.2 (page 10) show nonobviousness. However, the comparative examples relied upon instead demonstrate only that copious amounts of large zinc oxide particles reduce cling level. There is no evidence in this case which shows that inclusion of small amounts of small zinc oxide particles within the claimed ranges actually improve the cling level of the resulting film over a polymeric film of the same composition without any zinc oxide particles. As noted above, if the invention does no

more than return the polyethylene sheet to its natural cling level by including less zinc oxide than has been traditionally used in the prior art, it is submitted that this "increased" cling level produced by the natural cling of the resin would not be an unexpected result.

Therefore, a prima facie case of obviousness has been made because the prior art teaches the method of making the film using substantially the same ingredients, and Appellants have not successfully rebutted the rejection above because there is no evidence which can be given probative value. There are no substantive arguments against the Ealer reference.

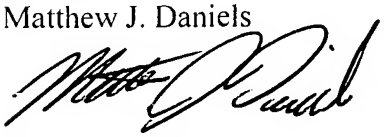
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Matthew J. Daniels



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